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09/524,849	03/14/2000	Esme M. Taylor	004717.P001	8171

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EXAMINER

NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/30/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/524,849

Applicant(s)

TAYLOR, ESME M.

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to claim 2, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

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feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "a single page with no sponsors", and the claim also recites "web page of a sponsor" which is the narrower statement of the range/limitation.

5. Claim 5 recites the limitation "the listee selected" on page 38, claim 5, lines 2-

3. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 6-9 are rejected for fully incorporating the deficiencies of the claim 5 from which they depend.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, US Patent No. 6,256,623 and further in view of Gupta et al. (Gupta), US Patent No. 6,487,538.

9. As to claim 1, Jones discloses a method comprising:

permitting a search (col. 7, line 59 – col. 8, line 17);

displaying a search result (col. 9, lines 1-11); and

Jones also discloses other frames in the search result containing advertising. However, Jones does not explicitly disclose incorporating a designated web page of a sponsor on the same page as the search result. In the same field of endeavor, Gupta discloses advertisements appear in connection with frequently used web sites or advertising scheme bases the advertisement on input from the user, such as if a search for baby books were made on a search engine Yahoo, the web host for Yahoo may display advertisements relating to baby merchandise such as strollers and high chairs (Abstract, col. 4, lines 14-65). Since Gupta teaches a method for searching on the Internet, which is similar to network search access construct for accessing web-based search services of Jones, thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Jones and Gupta to include incorporating a designated web based of a sponsor on the same page as the search result. Gupta suggests that by inserting advertisements into search result to gain publicity and web site access.

10. As to claim 2, Jones and Gupta disclose displaying a plurality of results on a single page, with no sponsors (Jones, col. 9, lines 1-11 and Fig. 5); and

when a user selects a single result, displaying the selected result with the incorporated designated web page of a sponsor (Gupta, (Abstract, col. 4, lines 14-65).

11. Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones and Gupta as applied to claims 1-2 above, and further in view of Leal, US Patent No. 6,189,003.

12. As to claim 3, Jones and Gupta disclose limitations as discussed in claims 1-2. However, Jones and Gupta do not explicitly disclose wherein the plurality of results are displayed with an essential element missing. Applicant describes an essential element is a telephone number in the specification. In the same field of endeavor, Leal discloses a user enters a search provider's web site, a search result a list of items containing a "direct connection" link (an essential element) (Fig. 7, and col. 10, line 50 – col. 11, line 5). Thus, it is obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Jones, Gupta, and Leal to include search results displayed with an essential element missing in order to provide users having possibility to make direct connection to web sites.

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13. As to claim 4, Jones, Gupta, and Leal (Jones-Gupta-Leal) disclose wherein the essential element comprises a telephone number in a telephone directory (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

14. As to claim 5, Jones-Gupta-Leal disclose wherein the plurality of results are displayed with a “call now button” that automatically connects the user with the listee selected (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

15. As to claim 6, Jones-Gupta-Leal disclose wherein a telephone call using the call now button is free to the user (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

16. As to claim 7, Jones-Gupta-Leal disclose wherein the telephone called may be charged to one of the following: the listee selected, the sponsor of the listee selected, or another sponsor (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

17. As to claim 8, Jones-Gupta-Leal disclose playing an advertising to the user prior to connecting the user with the listee selected (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

18. As to claim 9, Jones-Gupta-Leal disclose playing an advertising to the listee prior to connecting the user with the listee (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

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19. As to claim 10, Jones-Gupta-Leal disclose displaying a licensee's data if the user connected to the directory from a licensee (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

20. As to claim 11, Jones-Gupta-Leal disclose tracking the user for statistical and revenue sharing purposes (Gupta, col. 16, lines 35-61, and col. 17, lines 13-30).

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

22. Claims 12-26 are rejected under 35 U.S.C. 102 (e) as being anticipated by Gupta et al. (Gupta), US Patent No. 6,487,538.

23. As to claim 12, Gupta discloses a method comprising:

permitting purchase a sponsorship of at least one listing based on a criteria (col. 4, lines 5-65); and

identifying a designated web page for incorporation on the same page as the listing, when the sponsored listing is displayed as a search result (col. 4, lines 5-65).

24. As to claim 13, Gupta discloses wherein the criteria comprises one or more of the following: a ZIP code, a city, a region, a telephone number, and SIC code, a demographic, a keyword, or an individual listing (col. 4, lines 53-65, col. 5, lines 17-35, and col. 10, lines 41-63).

25. As to claim 14, Gupta discloses wherein the demographic may be selected by a location of a user of the search (col. 4, lines 53-60).

26. As to claim 15, Gupta discloses wherein the demographic may be based on a SIC code (col. 4, lines 53-60).

27. As to claim 16, Gupta discloses wherein the demographic maybe based on a category of the listing (Abstract).

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28. As to claim 17, Gupta discloses receiving a request for sponsorship of a group based on the criteria;

determining if the group is available for sponsorship (col. 12, lines 23-41); and
if the group is available for sponsorship, quoting a list price for the group (col. 12, lines 42-50).

29. As to claim 18, Gupta discloses if the sponsor agrees to pay the list price,
requesting the designated web page from the sponsor (col. 11, lines 126-65);
and

adding the sponsor and the designated web page into a database (col. 11, line 66 – col. 12, line 7).

30. As to claim 19, Gupta discloses linking the selected listee to the sponsor's web page (col. 12, lines 8-22);

designating a length of time the sponsor is linked to the listee (col. 4, lines 26-36,
and col. 5, lines 54-63);

selecting a number of times the sponsor wants the sponsor's page to be shown (col. 12, line 51 – col. 13, line 42); and

setting a price for the sponsor (col. 12, line 51 – col. 13, line 42);

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31. As to claim 20, Gupta discloses wherein setting the price comprises setting a price per impression or setting a price per time period (col. 4, lines 26-36, and col. 5, lines 54-63).

32. As to claim 21, Gupta discloses if the sponsor declines to pay the list price, prompting the sponsor to enter a bid for the sponsorship of the group (col. 13, lines 13-42); and opening an auction for the sponsorship of the group (col. 14, lines 19-47).

33. As to claim 22, Gupta discloses notifying bidders of the sponsorship of an outcome of the auction (col. 14, lines 19-47); and requesting the designated web page for the group from the sponsor who won (col. 14, lines 19-47); and adding the sponsor and the designated web page into a database (col. 11, line 66 – col. 12, line 7).

34. As to claim 23, Gupta discloses wherein the sponsorship comprises a price for each impression of the sponsor's designated web site with the at least one listing (col. 4, lines 26-36, and col. 5, lines 54-63).

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35. As to claim 24, Gupta discloses wherein the sponsorship may be a self-sponsorship, such that a web page displayed is a web page of the listee (col. 12, lines 8-22).

36. Claims 25-26 are corresponding apparatus claims containing similar limitations as discussed in claims 12-24; therefore, they are rejected under the same rationale.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner can normally be reached on Monday-Friday from 8:00 am to 6:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (703) 305-9792.

The fax phone numbers for the organization where this application is assigned are as follows:

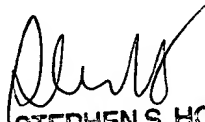
(703) 746-7238 (After Final Communications only)

(703) 746-7239 (Official Communications)

(703) 746-7240 (for Official Status Inquiries, Draft Communications only)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

Chau Nguyen
Patent Examiner
Art Unit 2176


STEPHEN S. HONG
PRIMARY EXAMINER